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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,452	12/11/2001	Rubin S. Rochlin		4380

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,452

Applicant(s)

ROCHLIN ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/31/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 10/31/2003. Applicants' cancellation of claims 1-3, and newly added claims 4-11 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Claim Objections

4. Claim 9 is objected to because of the following informalities:

In claim 9, line 3, please change ",", to --.--, at the end of the sentence.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, in claim 7, line 2, the recitation "void space is characterized as 100% open" appears to be new matter. Applicant is requested to point out express or inherent support in the specification, or delete the new matter.

7. Claims 4-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, claim 4 appears to be narrative in form and replete with indefinite and functional or operational language. In particular, it is noted that the preamble is directed to a filler material, whereas at lines 3-6, Applicant appears redefining the invention as a cushion, which renders the claim indefinite, because it is not clear whether the filler material alone, or the cushion is being claimed. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, for this Office action, claim 4 is presumed to be directed to a filler material, and the elements of a cushion are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Clarification and appropriate rewrite are requested.

Additionally, in claim 4, lines 9 and 12, the phrases "moment of inertia" and "level of yield" appear to be un-related to the flexibility (flexibly bend under pressure) and resiliency (repeatedly bounce back) of instantly claimed foam pieces, and as such

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render the instant invention vague, indefinite and confusing. It should be noted that while flexibility and resiliency are material properties, "moment of inertia" and "level of yield" relate to a state of the material under an external force, and are not inherent properties of the material. As such, they are not appropriate inventive elements in an article claim. Appropriate rewrite is required.

In claim 7, the phrase "void space" is vague and indefinite, because it is unclear as to the scope of the "void space". For this Office action, it is presumed that "void space" means "void volume". Further, the recitation that "void space is 100% open" is vague and indefinite, because it is unclear as to what is the meaning of a "void volume" being "open", as the "void space" (or "volume") is inherently open. For the purpose of this Office action, it is presumed to be meaning the cell structure is 100% open, which essentially duplicates the structural element in the base claim 4, as such the Examiner suggests deletion.

In claim 9, line 2, the Examiner repeats (see Paper No. 0722, page 3) that the phrase "last longer without matting" is vague and indefinite, i.e., it is unclear as to the scope of "last longer" and the meaning of "matting". For the purpose of this Office action, it is presumed that the resiliency of the filling material is greater than a regular polyurethane foam or synthetic fiber (See Specification, page 4, last paragraph).

Claims 10 and 11 provide for the use of the foam pieces of claim 4, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it

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merely recites a use without any active, positive steps delimiting how this use is actually practiced. Appropriate rewrite as method of use is suggested.

Response to Amendment

8. Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver (US 3761131), substantially for the reasons set forth in section 5 of Paper No. 0722, together with the following additional observations.

The Examiner repeats (see Paper No. 0722, page 4) that Oliver's invention is directed to a sofa-like article of furniture having pillow-like seat and back cushions. Each cushion consists of a flexible cover filled with a resilient particulate material such as chunks of polyurethane foam (Abstract), which clearly reads on the instantly claimed foam pieces as having a cross sectional area which bends flexibly, and bounce back repeatedly.

For claim 4, Oliver lacks an express teaching that the foam pieces have substantially 100% open cell. However, Oliver does teach that at least a portion of the covering material used in each cushion should be of the type which will "breathe" or allow air to pass through rapidly as the cushions are periodically compressed and released during use (column 2, lines 25-29). As such, since Oliver essentially teaches the same subject matter as the instantly claimed invention, it is believed that the foam pieces have substantially 100% open cell is either inherently disclosed by Oliver, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to be able to rapidly pass the air through the cushion.

For claims 5 and 6, Oliver is silent about the size and shape of the chunks of the foam. However, Oliver does show in Fig. 7 that the "chunks of foams" are relatively small and appears to have a variety of shapes. As such, in the absence of unexpected results, since Oliver essentially teaches the same subject matter as the instantly claimed invention for the same application (filling a resilient cushion), it is the Examiner's position that suitable size and shape of the foam pieces are either implicitly disclosed by Oliver, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain suitable foam pieces for cushion filling. It should be noted that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

Similarly, for claims 7 and 8, although Oliver is silent about the suitable void volume and the related density, since Oliver essentially teaches the same subject matter as the instantly claimed invention for the same application (filling a resilient cushion), in the absence of unexpected results, it is the Examiner's position that suitable void volume and density of the foam pieces are either inherently disclosed by Oliver, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain suitable foam pieces to form a resilient, highly breathable cushion, as set forth above.

Similarly, for claim 9, since Oliver teaches the essentially same polyurethane foam pieces for the same application (filling a resilient cushion), in the absence of

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unexpected results, it is the Examiner's position that suitable resiliency of the foam pieces are either inherently disclosed by Oliver, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain a suitable foam pieces to form a resilient cushion, as set forth above.

For claim 10, it is noted that claim lacks any structural elements other than the dependent upon base claim. It should be noted that a utility recitation in an article claim is improper and irrelevant, and as such it is rejected.

Similarly, for claim 11, it is noted that other than the suitable density of the foam pieces, which are believed to be either inherently disclosed by Oliver, or an obvious optimization to one of ordinary skill in the art, as set forth above, the claim lacks any structural elements other than the dependent upon base claim. As such, the Examiner notes that a utility recitation is also rejected, as set forth above.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DANIEL ZIRKER
PRIMARY EXAMINER
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